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APPLICATION NO.	FILED DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,500	10/24/2001	Guy Richards	24180-124005	3373
7590	08/27/2004			EXAMINER NOLAN, SANDRA M
Matthew E. Leno McDermott, Will & Emery 31st Floor 227 West Monroe Street Chicago, IL 60606			ART UNIT 1772	PAPER NUMBER
DATE MAILED: 08/27/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

A8

Office Action Summary	Application No.	Applicant(s)	
	10/046,500	RICHARDS ET AL.	
	Examiner	Art Unit	
	Sandra M. Nolan	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
 THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 16 August 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) 1-24 and 42-50 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 25-41 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>22 March 2004</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Claims

1. Claims 1-50 are pending. Claims 1-24 and 42-50 have been withdrawn.
2. Claims 25-41 are treated here. This action is based upon the text of claims 25-41 as they appear in the 13 November 2003 amendment.

Finality Withdrawn

3. The finality of the office action dated 13 May 2004 is hereby withdrawn in order to apply the new grounds of rejection below.

Information Disclosure Statement

4. The information disclosure statement (IDS) submitted on 22 March 2004 was considered by the examiner.

Rejections Withdrawn

5. The 35 USC 102 rejection of claims 25-28 and 30-41 as anticipated by Schmidt et al (US 5,804,016) is withdrawn in view of applicants' arguments on pages 2-3 of their 16 August 2004 response taken with the second declaration of co-inventor Dr. Robert Knoll, dated 16 August 2004.

6. The examiner is convinced that Schmidt's invention deals with processes of making multilayer preforms and containers in which the IV values recited in the patent's claims are important features of the processes. Since, as the Knoll declaration points out, polypropylene (PP) is not widely known as a polymer having the IV values recited in the Schmidt claims, Schmidt's process is deemed inapplicable to PP preforms and the configurations of Schmidt's preforms do not anticipate applicants' PP preforms.

Note: Dr. Knoll's first declaration, submitted with the 13 November 2003 amendment, was acknowledged twice in the 13 May 2004 office action. See page 2, section 3 and page 4, section 17(l)(a) of that action.

7. The 35 USC 103 rejection of claim 29 as unpatentable over Schmidt in view of Krishnakumar (US 5,303,834) is withdrawn in view of applicants' arguments on pages 2-3 of their 16 August 2004 response taken with the second declaration of co-inventor Dr. Robert Knoll, dated 16 August 2004.

See the discussion of the 16 August 2004 arguments and the second declaration, above.

New Rejections

Claim Rejection - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
9. Claim 29 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The container sidewall thickness range recited in line 2 of claim 29 does not coincide with the preform sidewall thickness limitation of claim 25 [that preform thickness be 2.3 times the thickness of the container] and the preform sidewall thickness range of claim 29.

Note that 2.3 times 0.025 is 0.0575; 2.3 times 0.032 is 0.0736. That gives a preform thickness range of 0.0575 to 0.0736, a range that barely overlaps the 0.0074 to 0.120 preform thickness range recited claim 29.

It is suggested that the text after "0.074-0.120 inch" in claim 29 be deleted.

Please clarify the claim.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 25-41 are rejected under 35 U.S.C. 102(b) as being anticipated by Agrawal et al (US 4,131,666).

Agrawal teaches preforms used in reheat processes (title, col. 1, line 12). The preforms are used to make containers having finishes, sidewalls and bases (Figure 4). As shown in Figure 2 and discussed at col. 3, lines 56 through col. 4, lines 29, the preform has a finish **14**, a body **12** and a base **22**. The preform's flange **18** is shown in Figure 2, but is not discussed in the text. The preforms are cylindrical, so that they have a longitudinal axis (see Figures 2 and 3).

The Agrawal preforms are made of thermoplastics such as polyethylene terephthalate (col. 6, lines 52-35) and propylene polymers (col. 6, lines 49-52 and col. 7, line 26).

The containers have radial stretch (B) values of 100 to 250% (i.e., 1:1 to 2.5:1).

Note that A + B is 130 to 180, so that B is 100 to 250 (col. 5, lines 61-64 and col. 6, lines 27-31). These values meet the “less than 4.5:1” and “1.5:1 to 4.5:1 ratios” of claims 30 and 31, respectively. They also meet the “less than 4.5:1” and “less than 1.6:1” requirements of claims 38 and 41, respectively.

Note Example I, in which the preform’s thickness is 0.399 cm or 153.54 mils (col. 8, lines 31-32) and bottles made from this preform had a minimal thickness of 38 mils (col. 9, line 32-34). Dividing 38 into 153.54 gives 4.04 for the ratio of the preform thickness to the bottle’s thickness. This number meets the “at least 2.3”, “at least 2.5”, “at least 2.7” and “at least 2.5” limitations of claims 25, 26, 27, and 28, respectively.

A bottle is deemed to be a container.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. Claims 25-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Agrawal in view of applicants' admissions in their specification at page 2, first full paragraph.

Agrawal is discussed above. It fails to recite the term "polypropylene".

Applicants' specification states that "PP" (defined at page 1 as referring to polypropylene) is cheaper and has better processability and physical properties than PET (defined at page 1 as referring to polyethylene terephthalate).

The citations are analogous because they both deal with PP as a raw material for making articles.

It would have been obvious to one having ordinary skill in the art at the time that the invention was made to employ the polypropylene of the specification as the polymers for making the preforms and containers of Agrawal in order to lower the cost and improve the processability and physical properties of the articles made.

The wall thickness ratio and radial stretch discussions above pertain to this rejection as well.

Citation as of Interest

14. Edwards (US 3,882,212) is cited as of interest for teaching that blow molded containers with minimum thicknesses of 0.008 inch (col. 1, lines 37) are made from preforms having average thicknesses of 0.02 inch (col. 2, lines 2-3). Since 0.02 divided by 0.008 is 2.5, the preforms are 2.5 times thicker than the containers.

Response to Arguments

15. Applicant's arguments with respect to claims 25-41 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication should be directed to Sandra M. Nolan, whose telephone number is 571/272-1495. She can normally be reached on Monday through Thursday, from 6:30 am to 4:00 pm, Eastern Time.

If attempts to reach the examiner are unsuccessful, her supervisor, Harold Pyon, can be reached at 571/272-1498.

The fax number for patent application documents is 703/872-9306.

S. M. Nolan
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Primary Examiner
Technology Center 1700

SMN/smn
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